

REMARKS

Applicant is in the process of correcting the drawings pursuant to the Examiner's comments in paragraph 2 of the Official Action. The corrected versions of the drawings will be sent by supplemental amendment promptly as soon as they are received.

The Examiner is requested to reconsider the rejection of the claims 1 - 3, 9 - 10, 14 - 15, 17, 19 - 20 under 35 U.S.C. §102(e) as being anticipated by Sakamoto, et al. (U.S. Patent No. 6,185,544B1).

Applicants respectfully submit that in view of the amendments to the aforementioned claims, the Sakamoto, et al. patent is not relevant with respect to claims 1 - 3, 9 - 10, 14 - 15, 17 and 19 - 20 present in the instant application. With the amendments to the claims, the Sakamoto, et al reference does not contain a disclosure of each and every element present in the claims noted. Accordingly a rejection under 35 U.S.C. §102(e) is no longer proper.

The Examiner is respectfully requested to reconsider his rejection of Claims 4 - 8, 11 - 13, 16 and 18 under 35 U.S.C. 103(a) as being unpatentable obvious as obvious over United States Patent 6,185,544B1 to Sakamoto, et al. in view of United States Patent 6,078,898 to Dasvis, et al.

Sakamoto, et al. teach a processing system for a request for an individual's charge a contemporary commercial establishment. Davis, et al. teach a system for transactional taxation which involve different steps from those disclosed by Applicant. The references both relate to transactions, but at that point the similarity ceases. There is no basis to combine the references.

In order to analyze the propriety of the Examiner's rejections in this case, a review of the pertinent applicable law relating to 35 U.S.C. § 103(a) is warranted. The Examiner has applied the various references discussed above using selective combinations to render obvious the invention.

The Court of Appeals for the Federal Circuit has set guidelines governing such application of references. These guidelines are, as stated are found in Interconnect Planning Corp. v. Feil, 774 F.2d 1132, 1143, 227 USPQ, 543, 551:

When prior art references require selective combination by the court to render obvious a subsequent invention, there must be some reason for the combination other than hindsight gleaned from the invention itself.

A representative case relying upon this rule of law is Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 5 USPQ 2d 1434 (Fed. Cir. 1988). The district court in Uniroyal found that a combination of various features from a plurality of prior art references suggested the claimed invention of the patent in suit. The Federal Circuit in its decision found that the district court did not show, however, that there was any teaching or suggestion in any of the references, or in the prior art as a whole, that would lead one with ordinary skill in the art to make the combination. The Federal Circuit opined:

Something in the prior art as a whole must suggest the desirability, and thus the obviousness, of making the combination. [837 F.2d at 1051, 5 USPQ 2d at 1438, citing Lindemann, 730 F.2d 1452, 221 USPQ 481, 488 (Fed. Cir. 1984).]

Applicants respectfully submit that there is no basis for the combination of the Sakamoto et al. and Davis, et al. references cited by the Examiner. The references teach in different directions. The Examiner has selected elements and/or steps from disparate references for the sake of showing the individual elements and/or steps claimed, without regard to the total teaching of the references.

As noted, the Examiner is improperly picking and choosing. It is a piecemeal construction of the invention. Such piecemeal reconstruction of the prior art patents in light of the instant disclosure is contrary to the requirements of 35 U.S.C. § 103.

The ever present question in cases within the ambit of 35 U.S.C. § 103 is whether the subject matter as a whole would have been obvious to one of ordinary skill in the art following the teachings of the prior art at the time the invention was made. It is impermissible within the framework of Section 103 to pick and choose from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art. (Emphasis in original) In re Wesslau 147 U.S.P.Q. 391, 393 (CCPA 1965)

This holding succinctly summarizes the Examiner's application of references in this case, because the Examiner did in fact pick and choose so much of the references to support his position and did not cover completely in the Office Action the full scope of what these reference disclosure fairly suggest to one skilled in the art.

Further, the Federal Circuit has stated that the Patent Office bears the burden of establishing obviousness. It held this burden can only be satisfied by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the reference.

Obviousness is tested by "what the combined teachings of the references would have suggested to those of ordinary skill in the art." In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981). But it "cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination." ACS Hosp. Sys., 732 F.2d at 1577, 221 USPQ at 933. [837 F.2d at 1075, 5 USPQ 2d at 1599.]

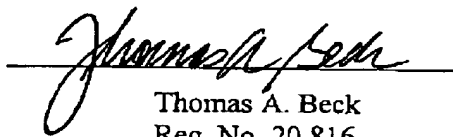
The court concluded its discussion of this issue by stating that teachings or references can be combined only if there is some suggestion or incentive to do so.

In the present case, the skilled artisan, viewing any or all of the references would be directed toward a totally different system from that which is called for in the present invention. Because the references describe inventions which are substantially different, there is no proper basis to combine them.

Applicants have attempted in this response to amend the claims to place the claims in a form which should result in their allowability. If the Examiner wishes to discuss via telephone the substance of any of the proposed claims contained herein with the intent of putting them into an allowable form, Applicants' attorney will be glad to speak with the Examiner at a mutually agreeable time and will cooperate in any way possible.

In view of the arguments and modifications to the claims, allowance of this case is warranted. Such favorable action is respectfully solicited.

Respectfully submitted,


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